REMARKS

This Amendment and Reply responds to the Office Action mailed April 3, 2006.

Summary of the Office Action

In this Office Action, claims 7-12 and 15 were rejected under 35 U.S.C. 112, second paragraph. Claims 1-6 and 13-14 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,989,193 to Sullivan, hereafter Sullivan. Claims 7-12 and 15 were rejected under 35 U.S.C. 103(a) as unpatentable over Sullivan in view of U.S. Patent 5,490,502 to Rapoport et al, hereafter Rapoport.

In response, claims 1, 2, 7, and 8 have been canceled. Independent claims 13, 14, and 15 have been amended. Claims 3 and 9 have been rewritten in independent form.

Response to 112(2) Rejection

Regarding the 112(2) rejections, claims 7-12 and 15 have been amended to include limitations matching the language in the preamble cited by the examiner. As diagnosing and analyzing elements are now present, no gaps currently exist between element. Thus, the rejection under 112(2) should be withdrawn.

Response to 102(b) Rejection

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. 2131. As amended, all independent claims now recite limitations not found in the references cited by the examiner. Therefore, the rejections under 35 U.S.C. 102(b) should be withdrawn.

Specifically, Sullivan does not disclose the recited procedure for calculating correlation coefficients. The section of Sullivan listed by the examiner [col. 6, lines 40-43] only indicates that "the signals output from the signal processing means 16 are stored in a digital recording system 19 and computer memory for later playback and analysis." Sullivan lacks the analysis elements presented in the amended claims, having nothing that

either expressly or inherently describes a "reference data moving period" or a "comparison data moving period." Sullivan also does not define the use of first, second, and third predetermined periods during calculation, as recited in all pending claims.

Response to 103(a) Rejection

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2142.

Here, the prior art references when combined neither teach nor suggest all of the claim limitations. Sullivan, as described for the anticipation rejection, lacks the recited limitations for correlation coefficient calculation. Rapoport does not supply these missing elements.

The examiner listed column 8, lines 49-67 in Rapoport. While Rapoport does mention a correlation coefficient [col. 8, line 50], it neither teaches nor suggest the use of a "reference data moving period" and a "comparison data period." Instead, Rapoport only indicates that a half sinusoidal template [col. 8, lines 52-53] is compared to the actual total inspiratory flow data [col. 8, lines 54-55]. There is no disclosure in Rapoport of a comparison data moving period being shifted from the reference data moving period by a first predetermined period.

Moreover, Rapoport lacks the recited second and third predetermined periods. Rapoport neither teaches nor suggests "shifting within the reference data moving period by a second predetermined period" nor "shifting within the comparison data moving period by a third predetermined period." during correlation coefficient calculation. The

examiner has not cited any other prior art references that anticipate these limitations or render them obvious.

Accordingly, the present invention is not rendered obvious by the combination of the Sullivan and Rapoport patents because the correlation coefficient calculation limitations are not taught in either patent. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP § 2143.03. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 3-6 and 9-15.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that all objections be withdrawn and that a notice of allowance be forthcoming. The Examiner is invited to contact the undersigned for any reason related to the advancement of this case.

Respectfully submitted,

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